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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,682	02/05/2001	Anthony Ross Glen Stollery	08059.0008	3226
22852	7590	09/23/2005	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			JANVIER, JEAN D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/719,682

Applicant(s)

STOLLERY, ANTHONY ROSS  
GLEN

Examiner

Jean Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/02/2005 has been entered and a Non-Final Action follows.

**Response To Applicant's amendments**

The Examiner does not approve the new title of the invention "Method Of Retail Data Manipulation In Combination With A Jackpot". A preferred and suggested title is "A System For Deducting And Adding a Percentage Of A customer's Purchase Amount To A Jackpot".

Further, the replacement drawing is approved by the Examiner.

Finally, it appears that the amendment made to independent claim 16 has introduced new matter therein or it is not supported in the specification, at least as originally filed. Indeed, the Examiner has read the entire Application disclosure and cannot find clear support, under 112(1), for **"...wherein the number of times the random number generator is operated is proportional to the purchase amount"** and the disclosure provided on page 4: 11-17, page 7: 13-23 and page 8: 2-3 cannot compensate for this lack of support. Even if the specification were to support the new claim language, then the claim would have been ambiguous or confusing or indefinite, under 112(2), since it is unclear whether or not the customer's name is being entered into a jackpot each time he makes a purchase at a participating retailer (multiple entries for one

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account), thereby having more chances to win the jackpot, or the customer has a chance to receive more money if he wins the jackpot if the percentage deducted from the purchase amount yields to a larger dollar amount than a minimum required. Thus, the claim will be broadly interpreted and the arguments associated therewith are immediately moot.

### **Response To Applicant's Arguments**

In general, the new arguments are based, at least in part, on the amendment and these arguments are moot as discussed above.

Furthermore, the Applicant keeps on referring to Kalina in his remarks as if Kaline was explicitly used as a reference in the last rejection. Although the Kalina's reference was cited to support the Examiner's assertion or the taking of "Official Notice", however, that reference was not expressly used as a secondary reference in the 103 section and thus, it is inappropriate to base the current arguments on Small and **Kalina**.

Additionally, and contrary to the Applicant's contention, the motivation to combine the "Office Notice" with the Small's reference is well within the level of skills of an ordinary skilled artisan who, using or implementing the system of Small, would have been encouraged at the time of the invention to incorporate the publicly disclosed information into the Small's system so as to provide an incentive to a customer by computing from the customer's transaction amount a certain variable percentage, due to the customer, based on the dollar amount spent (volume purchase) during a current transaction, wherein this dollar amount meets one preset threshold value among a plurality of predetermined thresholds and wherein the computed percentage (incentive) is used to pay for the chance to enter the customer's account in a lottery game or

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+jackpot, thereby encouraging the customer to patronize or support the local participating retailer or merchant by purchasing products or services available at the retailer's POS and using a branded credit/debit card to pay for the transaction and wherein, for each transaction conducted at the retailer or another associated retailer, the customer's account number is entered into a lottery game or game of chance, which gives the customer an opportunity to win a big jackpot or

Therefore, the Applicant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Applicant's arguments as herein presented are not plausible and thus, the last Office Action is hereby being maintained.

#### **Detailed Action**

#### ***Specification***

The title of the invention should be brief, descriptive and technically accurate.. See 37 CFR 1.72. A preferred and suggested title is **"A System For Deducting And Adding a Percentage Of A customer's Purchase Amount To A Jackpot."**

On page 5, line 3, "...to provide the potential and incentive..." should apparently be -- ....to provide the potential incentive....--.

On page 5, lines 22 and 23, "The preferred embodiments of the present invention...." Should apparently be --In the preferred embodiments of the present invention....--.

#### ***Status of the claims***

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Claims 1-15 were canceled and claims 16-21 were added. Hence, claims 16-21 are currently pending in the Application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 (including dependent claims 17-21) is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 16 has introduced new matter therein or it is not supported in the specification, at least as originally filed. Indeed, the Examiner has read the entire Application disclosure and cannot find clear support, under 112(1), for “...**wherein the number of times the random number generator is operated is proportional to the purchase amount**” and the disclosure provided on page 4: 11-17, page 7: 13-23 and page 8: 2-3 cannot compensate for this lack of support. Even if the specification were to support the new claim language, then the claim would have been ambiguous or confusing or indefinite, under 112(2), since it is unclear whether or not the customer’s name is being entered into a jackpot each time he makes a purchase at a participating retailer (multiple entries for one account), thereby having more chances to win the jackpot, or the customer has a chance to receive more money if he wins the jackpot if the

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percentage deducted from the purchase amount yields to a larger dollar amount than a minimum required. Thus, the claim will be broadly interpreted.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 16 (including dependent claims 17-21) is rejected under 35 USC 112(2) for being ambiguous or confusing. The limitation "...wherein the number of times the random number generator is operated is proportional to the purchase amount", recited therein, renders the claim ambiguous or confusing or indefinite since it is unclear whether the customer's name is being entered into a jackpot each time he makes a purchase at a participating retailer (multiple entries for one account), thereby having more chances to win the jackpot, or the customer has a chance to receive more money if he wins the jackpot if the percentage deducted from the purchase amount yields to a larger dollar amount than a minimum required. Thus, the claim will be broadly interpreted.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to

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which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Small, US Patent 4,669, 730.

As per claims 16-21, Small discloses a system for encouraging a customer or user to conduct a transaction at an ATM machine or at a participating retailer's or merchant's POS, wherein the customer uses a debit/credit card to withdraw money from the ATM machine or to pay for a purchase at the participating retailer's POS by inputting his PIN number into a terminal related to the ATM or POS and wherein the customer's account is automatically entered into a game of chance or sweepstakes (jackpot). Subsequently, the user or customer may win a prize (jackpot) based upon the outcome of the game of chance or the sweepstakes drawing (See abstract; col. 2: 11 to col. 4: 24). Furthermore, and in general, Small discloses the steps of:

Conducting at least one draw for each transaction at an ATM 2 terminal (fig.1) or P.O.S. Terminal 12 of fig.2 involving a debit card, ATM card or credit card (col. 6: 9-11);

Determining an award to a buyer or customer at P.O.S. Terminal 12 based on an outcome of the draw if the user's indicia or account matches the game drawing indicia (col.5: 39-45);

Receiving from the buyer information such as user's financial institution account number (col. 5: 39-41) for the draw; and

Affecting an outcome of the draw based on the received information (col.5,



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lines 41-45).

Moreover, Small discloses, in figs. 1-3, an ATM machine (2) or a POS terminal (12) (dedicated terminal) connected to a sweepstakes processor 5 (electronic data manipulation system or jackpot processor), which is adapted or configured to perform a lottery or a sweepstakes draw at a certain time period as users or customers are using their branded cards in transactions at participating POSes.

In one embodiment, Small teaches a system wherein in areas where lottery games are permitted, the apparatus, as shown in figs. 1-3, is designed to be utilized as a lottery machine. The components are substantially similar, although a user would be required to pay consideration for the chance to enter the lottery sweepstakes. Preferably, a separate function key would be provided on the ATM or POS terminal whereby the user could designate an amount of money to be withdrawn from the user's financial institution account and applied toward the lottery. This separate sweepstakes key could also be used on the standard sweepstakes-type game to increase user awareness. **Finally, the sweepstakes computer 5 is programmed to accommodate either an instantaneous lottery determination or to enter the user's account number or other user indicia into a longer term lottery, as is well known in the art. In this case, a winner can win a big jackpot comprising wagers or bets from other users or players, as practiced in the industry (col. 4: 24-39).** It is contemplated here that the retail POS or the ATM is adapted to display the jackpot value or the prize won (intended use).

As per claim 16 and 18, Small does not expressly teach adding a percentage of the purchase amount to a jackpot total and varying by the retailers the percentages contributed.

However, It is common practice for a retailer or manufacturer to give an incentive to a customer during a transaction at a POS. For example, a participating retailer or merchant will compute from a customer's bill or balance due during a visit at the retailer's POS a certain percentage savings, due to the customer, if the customer's transaction amount falls within one or more preset thresholds (volume purchase). In other words, the percentage varied based on the value of the transaction with respect to a preset threshold.

Moreover, it is well taught in the art that a manufacturer or a retailer may provide an incentive (dollar amount) to a customer for performing a particular task and wherein this incentive or dollar amount is invested at an investment firm on behalf of the customer in an effort to encourage the customer to continue performing the particular task.

“Official Notice”.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure into the system of Small so as to provide an incentive to a customer by computing from the customer's transaction amount a certain variable percentage, due to the customer, based on the dollar amount spent (volume purchase) during a current transaction, wherein this dollar amount meets one preset threshold value among a plurality of predetermined thresholds and wherein the computed percentage (incentive) is used to pay for the chance to enter the customer's account in a lottery game or jackpot, thereby encouraging the customer to patronize or support the local participating retailer or merchant by purchasing products or services available at the retailer's POS and using a branded credit/debit card to pay for the transaction and wherein, for each transaction conducted at the retailer or

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another associated retailer, the customer's account number is entered into a lottery game or game of chance, which gives the customer an opportunity to win a big jackpot or prizes or free merchandises.

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,267,670 to Walker discloses a system and method for performing integrated lottery ticket and merchandise transactions using a point-of-sale terminal that generates a single sales receipt containing all pertinent lottery ticket and merchandise transaction information. The lottery tickets generated include fractional value and "quick-pick" lottery tickets. A group of point-of-sale terminals are connected to a POS controller, which communicates with a lottery data processing system. An encrypted authentication code also printed on the sales receipt allows the lottery player to verify all lottery ticket transaction information, as needed. In at least one embodiment, a method is provided for performing a lottery ticket transaction at a point-of-sale terminal. The method includes the steps of (1) calculating a change amount of a merchandise transaction; (2) receiving a request to purchase a lottery ticket in exchange for the change amount; (3) transmitting a request for a lottery ticket, the request including the change amount; (4) receiving lottery ticket information that is based on the change amount; and (5) printing the lottery ticket information on a receipt if the request to purchase a lottery ticket in exchange for the change amount is received, the lottery ticket information including a plurality of lottery numbers. Numerous other embodiments are also provided.

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Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official- 571-273-6719.

Official Draft : 571-273-8300

09/19/05

**JDJ**

**Jean D. Janvier**

**Patent Examiner**

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**JEAN D. JANVIER  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Janvier Jean Dario", written over the printed name and title.